

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINHOLD CARLE and OTTO ISAAC

Appeal No. 93-2757
Application 07/908,856¹

ON BRIEF

Before WINTERS, SOFOCLEOUS and GRON, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

¹ Application for patent filed July 1, 1992. According to appellants, this application is a continuation of Application 07/780,387, filed October 23, 1991, now abandoned; which is a continuation of Application 07/155,555, filed February 12, 1988, now abandoned.

Appeal No. 93-2757
Application 07/908,856

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 7 through 14, which are all of the claims remaining in the application.

REPRESENTATIVE CLAIMS

Claims 13 and 14, which are illustrative of the subject matter on appeal, read as follows:

13. A process for the manufacture of camomile oil having a high content of natural spiroethers including a cis-spiroether content of at least 0.5 mg per 100 g of the camomile oil and a trans-spiroether content of at least 0.3 mg per 100 mg of camomile oil, which process comprises subjecting an extraction residue of a camomile extraction to steam distillation or to an aqueous distillation.

14. A process for the manufacture of camomile oil having a high content of natural spiroethers including a cis-spiroether content of at least 0.5 mg per 100 g of the camomile oil and a trans-spiroether content of at least 0.3 mg per 100 mg of camomile oil, which process comprises subjecting fresh camomile, Matricaria Chamomilla (L.), to steam distillation or to an aqueous distillation.

THE PRIOR ART REFERENCE

The prior art reference cited and relied on by the examiner is:

Franz et al.
(UK Patent Application)

GB 2 170 404 A

Aug. 6, 1986

THE ISSUE

Appeal No. 93-2757
Application 07/908,856

The issue presented for review is whether the examiner erred in rejecting claims 7 through 14 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as unpatentable over GB 2 170 404 A.

DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) appellants' main Brief and Reply Brief before the Board; (3) the Examiner's Answer and the communication mailed by the examiner March 28, 1996 (Paper No. 39); (4) GB 2 170 404 A; (5) the Carle Declaration, filed under the provisions of 37 CFR § 1.132, executed May 20, 1992; and (6) the opinion and decision entered by a different merits panel of this Board in Serial No. 07/155,555 (Appeal No. 90-1845, dated August 28, 1991).

On consideration of the record, including the above-listed materials, we affirm the examiner's decision rejecting claims 7 through 13. However, we reverse the examiner's decision rejecting claim 14.

CLAIMS 7 THROUGH 13

Claims 7 through 13 define a process for manufacturing camomile oil having a high content of natural spiroethers, wherein the manipulative step comprises subjecting "an extraction residue of a camomile extraction" to steam or aqueous distillation. The relatively broad phrase "an extraction residue of a camomile extraction" places no restriction on the nature or parameters of the extraction step. Furthermore, the extraction residue may be, for example, a dry residue. See the instant specification, page 8, second full paragraph.

Giving these claims their broadest reasonable interpretation consistent with the specification, In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983), we conclude that appellants' starting material "reads on" the dried camomile flowerheads or drug of the camomile as disclosed by GB 2 170 404 A in Example 1, page 13, lines 4 through 18. Simply stated, we discern no limitation in claims 7 through 13 serving to distinguish "an extraction residue of a camomile extraction" from the dried flowerheads disclosed by the reference. Again, during patent examination, pending claims must be interpreted as broadly as their terms reasonably allow.

Appeal No. 93-2757
Application 07/908,856

In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

GB 2 170 404 A describes a process for preparing camomile oil which comprises subjecting dried camomile flowerheads or drug of the camomile to aqueous or steam distillation. See page 16, Example 7 of the reference. This reasonably appears to constitute a description of the invention defined in claims 7 through 13 within the meaning of 35 U.S.C.

§ 102(b). Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). See also In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (discovery of a new benefit of an old process does not make the old process patentable again).

Accordingly, we affirm the examiner's decision rejecting claims 7 through 13 on prior art grounds based on GB 2 170 404 A.

CLAIM 14

In Example 7, page 16, GB 2 170 404 A discloses a process for preparing camomile oil which comprises subjecting dried camomile flowerheads to aqueous or steam distillation. Claim 17 of the reference, page 19, describes in relevant part "[a]n

Appeal No. 93-2757
Application 07/908,856

essential oil obtained using fresh, frozen or dried flowers of a tetraploid camomile as claimed in claim 1 or 2" (emphasis added).

To sustain the examiner's rejection of claim 14 under 35 U.S.C. § 102(b), it would be necessary to combine the disclosures of Example 7 and claim 17 of the British patent. This is improper. As stated in In re Arkley, 455 F.2d 586, 587-88, 172 USPQ 524, 526 (CCPA 1972):

Thus, for the instant rejection under 35 U.S.C. § 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. Such picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a 102, anticipation rejection.

Accordingly, we shall not sustain the examiner's rejection under 35 U.S.C. § 102(b) because "such picking and choosing" has no place in the making of a § 102 rejection.

Furthermore, GB 2 170 404 A expounds the importance of drying camomile flowerheads during recovery of the drug. The

reference teaches that the temperature of drying is a result-effective variable, i.e., drying the flowerheads at temperatures no higher than 50°C produces a relatively high content of chamazulene and (-)- α -bisabolol in the recovered product. See the reference, page 7, line 62 through page 8, line 30; page 9, lines 46 through 52; and page 13, lines 4 through 25. On these facts, we do not believe that claim 17 of GB 2 170 404 A, considered in conjunction with Example 7, unequivocally describes a process of subjecting fresh camomile flowers to aqueous or steam distillation. Rather, the more plausible interpretation of the reference is that fresh flowerheads are used to prepare dried flowerheads which, in turn, are used to prepare essential oils by aqueous or steam distillation. To the extent that the previous Board opinion (Appeal No. 90-1845, dated August 28, 1991) may be interpreted as finding that Example 7 of the British patent, coupled with claim 17 therein, describes the invention here defined in claim 14, we disagree.

For these reasons, we reverse the rejection of claim 14 under 35 U.S.C. § 102(b) based on the description in GB 2 170 404 A.

We shall not pass on the question whether the invention defined in claim 14 would have been prima facie obvious over GB 2 170 404 A. Rather, for the purposes of this appeal, we shall assume *arguendo* that GB 2 170 404 A establishes a case of prima facie obviousness of this claim. The Carle Declaration, however, rebuts any such prima facie case.

In the Carle Declaration, executed May 20, 1992, the declarant conducted side-by-side tests comparing the aqueous distillation of fresh and dried camomile flowers. Both distillations were carried out "exactly as in Example 7 of British patent 2 170 404." As reported in the declaration, the aqueous distillation of fresh flowers provided a significantly enhanced yield of (-)-bisabolol, chamazulene, cis-spiroether and trans-spiroether.

The examiner does not critique the Carle Declaration in any manner whatsoever, e.g., by arguing that the tests therein are not truly comparative or that the results achieved are merely expected or that the enhanced yields of (-)-bisabolol, chamazulene, cis-spiroether and trans-spiroether are insignificant. On the contrary, with respect to the declaration evidence, the examiner is silent. This

constitutes reversible error. As stated in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d 1476, 1483, 44 USPQ2d 1181, 1186 (Fed. Cir. 1997), quoting from In re Soni, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), "all evidence of nonobviousness must be considered when assessing patentability."

On this record, we find that (1) the distillation of fresh camomile flowers gives rise to unexpectedly superior results as reported in the Carle Declaration, and (2) the declaration evidence serves to rebut any prima facie case of obviousness of claim 14 said to be established by 2 170 404 A. On the strength of the declaration evidence, we reverse the examiner's rejection of claim 14 under 35 U.S.C. § 103.

CONCLUSION

For the reasons set forth in the body of this opinion, we affirm the examiner's decision rejecting claims 7 through 13 on prior art grounds based on GB 2 170 404 A. We reverse the rejection of claim 14 under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103 as unpatentable over GB 2 170 404 A. Accordingly, the examiner's decision is affirmed-in-part.

Appeal No. 93-2757
Application 07/908,856

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	
MICHAEL SOFOCLEOUS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
TEDDY S. GRON)	
Administrative Patent Judge)	

Appeal No. 93-2757
Application 07/908,856

Cushman, Darby & Cushman
9th Floor
1100 New York Ave.
Washington, DC 20005-3918